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EXAMINER

BRIER, JEFFERY A

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/930,115
Filing Date: August 14, 2001
Appellant(s): SAMRA ET AL.

MAILED

DEC 27 2007

Technology Center 2600

Brian Young
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/16/2007 appealing from the Office action mailed 10/18/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

Appellant's brief presents arguments at pages 9 and 10 relating to non-entry of the 16 March 2007 after final amendment. This issue relates to petitionable subject matter under 37 CFR 1.181 and not to appealable subject matter. See MPEP § 1002 and § 1201. Appellants arguments concerning non-entry of the 16 March 2007 after final amendment in the 5/16/2007 Advisory Action was first raised in the Appeal Brief

filed on 10/16/2007 which is more than two months after the amendment was denied entry. In view of MPEP 1201 and 37 CFR 1.181(f) this petitionable argument is untimely.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,751,507	Hama et al.	6-1988
5,864,782	Mederer et al.	1-1999

IBM Technical Disclosure Bulletin titled Project Management published February 1, 1990, Vol. No. 32, Issue No. 9A, Page Nos. 250-254.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22:

At line 2 "the at least one node" lacks antecedent basis in the claim since claim 21 was amended to claim a "first set of nodes".

At line 2 "an outer node" is indefinite because at line 3 of claim 21 "a first set of nodes" and at line 8 of claim 21 "a second set of nodes" are claimed to form the plurality of nodes while line 2 of this claim does not clarify if the claimed "an outer node" is a one of the nodes in the second set of nodes or if it is another node. Even in light of the specification the meaning of "the plurality of nodes includes the at least one node and an outer node" is unclear.

At lines 3 and 4 the claim is unclear if the second set of nodes is being replaced by a single node.

Claim 23:

At line 3 "the at least one node" and "the outer node" lacks antecedent basis in the claim since claim 21 was amended to claim a "first set of nodes" and a "second set of nodes".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hama et al., U.S. Patent No. 4,751,507 in view of IBM Technical Disclosure Bulletin titled Project management Environment and in view of Mederer et al., US Patent No. 5,864,782.

Claim 21:

Hama teaches a method for viewing an image on a display screen (*see figures 1 and 5*),

Hama does not teach wherein the image includes a plurality of nodes in a flowgraph, wherein lines are used to interconnect a first set of nodes in the plurality of nodes that are displayed in a section of the display screen,

Hama teaches wherein a portion of the image are is displayed in the section of the display screen (*see figures 1 and 5*) the method comprising:

displaying a navigator box (*22 of figure 5*) on the display screen;

Hama does not teach ,wherein the navigator box provides a miniature representation of a second set of nodes of the plurality of nodes;

Hama teaches displaying an inner box (*25 of figure 5*) within the navigator box (*22*),

Hama does not teach wherein the inner box provides a miniature representation of the first set of nodes of the plurality of nodes in the flowgraph,

Hama teaches wherein edges of the inner box correspond to edges of the display screen (*this claim limitation is broad since it does not state how many edges correspond to the edges of the display screen, box*

indicating area 25 corresponds to display screen area 23 and display screen area 23 has at least three edges corresponding to the edges of the display screen, thus, inner area 25 has at least three edges corresponding to the edges of the display screen);

Hama teaches displaying a miniature version of the portion of the image on the display screen within the inner box (*within 22 is shown a small version of the evergreen tree shown in 23*) in correspondence with the portion of the image's position with respect to the edges of the display screen (*since at least three edges correspond to the edge of the display screen then Hamas' inner box is in correspondence with the edges of the display screen*), wherein the portions of the off screen image are shown in miniature within the area of the navigator box (22) that is outside of the inner box (25);

Hama does not teach such that the first set of nodes and the second set of nodes display the plurality of nodes in the flowgraph in the navigator box and the inner box; and

omitting display of the lines interconnecting the plurality of nodes in the flowgraph displayed within the inner box and the navigator box.

Hama teaches the image to be a computer controlled graphic application, column 1 lines 10-11, a stored image representation, column 1 line 34, and an image comprising a house, tree and flower, illustrated in figure 5.

The IBM Technical Disclosure Bulletin teaches displaying a flowchart that is larger than the display and allowing the user to scroll through the flowchart to view different areas of the flowchart, see page 6 of the EAST printout of this document.

Figure 1 of Mederer teaches to one of ordinary skill in the art displaying only the nodes in a flowgraph when the flowgraph is very large. Figures 2 and 3 teaches to one of ordinary skill in the art displaying the lines between the nodes of the flowgraph when a few nodes are displayed. MPEP 2125 discusses using drawings as a prior art teaching.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to display a flowgraph image in Hama because a flowgraph is an image corresponding to a computer controlled graphic application and because the IBM Technical Disclosure Bulletin teaches displaying a flowchart image that is larger than the display and it would have been obvious to one of ordinary skill in the art at the time the invention was made to display in the navigator box an image of the flowgraph where the flowgraph does not show the lines interconnecting the nodes because displaying a large flowgraph in a small area of the display with the lines will make the nodes of the flowgraph indiscernible.

Claims 22-24 vary the number of nodes displayed in the inner box and displayed outside the inner box within the navigator box which varied number is taught by or suggested by the flowchart of the IBM technical disclosure bulletin and by the flowgraph of Mederer.

The 5/16/2007 Advisory action stated in paragraph 1:

The after final amendment filed on 03/16/2007 has not been entered because the changes to claims 22 and 23 raise new issues. The changes to claim 22 appear to claim the same thing claimed in parent claim 21 note lines 7-8, 9-11, and 14-17 of claim 21. Additionally due to the claim limitation at line 3 "is included" the contents of the off-screen image is unclear since lines 7-8 and 14-17 of claim 21 define the navigator box as displaying off-screen nodes and line 3 of claim 22 is attempting to broaden claim 21 by implying the second set of nodes "is included" in the off-screen image and displayed in the area of the navigator box that is outside of the inner box since the word "included" implies there is additional items in the navigator box such as the lines between the second set of nodes. Thus, the changes to claim 22 raise new issues and the issue of new matter under 35 USC 112 first paragraph. The changes to claim 23 appear to claim the line omission only occurs between "a line interconnecting a node in the first set of nodes and a node in the second set of nodes" which implies interconnecting lines are displayed between the remaining nodes of the first and second nodes. Thus, the changes to claim 22 raise new issues and the issue of new matter under 35 USC 112 first paragraph.

(10) Response to Argument

Rejections under 35 U.S.C. § 112

Appellants argument is not persuasive to overcome the final rejection of claims 22 and 23 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because:

1) the non-entry of the 16 March 2007 after final amendment argued at pages 9 and 10 of the Appeal Brief is a petitionable matter under 37 CFR 1.181 and not an appealable subject matter, See MPEP § 1002 and § 1201, and

2) the after final amendment to claims 22 and 23 raised new issues and new matter issues. The 5/16/2007 Advisory action stated in paragraph 1:

The after final amendment filed on 03/16/2007 has not been entered because the changes to claims 22 and 23 raise new issues. The changes to claim 22 appear to claim the same thing claimed in parent claim 21 note lines 7-8, 9-11, and 14-17 of claim 21. Additionally due to the claim limitation at line 3 "is included" the contents of the off-screen image is unclear since lines 7-8 and 14-17 of claim 21 define the navigator box as displaying off-screen nodes and line 3 of claim 22 is attempting to broaden claim 21 by implying the second set of nodes "is included" in the off-screen image and displayed in the area of the navigator box that is outside of the inner box since the word "included" implies there is additional items in the navigator box such as the lines between the second set of nodes. Thus, the changes to claim 22 raise new

issues and the issue of new matter under 35 USC 112 first paragraph. The changes to claim 23 appear to claim the line omission only occurs between "a line interconnecting a node in the first set of nodes and a node in the second set of nodes" which implies interconnecting lines are displayed between the remaining nodes of the first and second nodes. Thus, the changes to claim 22 raise new issues and the issue of new matter under 35 USC 112 first paragraph.

A typo exists in the last sentence where 22 should be 23 since the last sentence is connected by the word "thus" to the previous sentence discussing claim 23.

The argument concerning claim 22 amended in the 3/16/2007 after final amendment and denied entry in the 5/16/2007 Advisory action is not persuasive.

The American Heritage dictionary definition provided by appellant and arguments at page 9 is noted, however, it is not persuasive to overcome the new issues and the issue of new matter position of this claim because:

1) the proposed changes to claim 22 claim the same thing claimed in parent claim 21, note lines 7-8, 9-11, and 14-17 of claim 21, and

2) the proposed claim limitation at line 3, "second set of nodes in the plurality of nodes is included in the off-screen image" is unclear since lines 7-8 and 14-17 of claim 21 define the navigator box as displaying off-screen nodes and line 3 of claim 22 is attempting to broaden claim 21 by implying the second set of nodes "is included" in the off-screen image and displayed in the area of the navigator box that is outside of the inner box since the word "included" implies there is additional items in the navigator box

such as the lines between the second set of nodes, as evidenced by appellants American Heritage dictionary definitions 1, 2, and 3.

The argument concerning claim 23 amended in the 3/16/2007 after final amendment and denied entry in the 5/16/2007 Advisory action is not persuasive.

The argument is not persuasive to overcome the new issues and the issue of new matter of this claim because this claim's proposed amendments broadens parent claim 21 by claiming the line omission occurs between "a line interconnecting a node in the first set of nodes and a node in the second set of nodes" which means due to the open ended phrase "comprises" interconnecting lines are displayed between the remaining nodes of the first set of nodes and the second set of nodes.

Rejections under 35 U.S.C. § 103

Appellants argument at pages 10-12 have been fully considered, however, they are not persuasive to overcome the obvious rejection based upon Hama et al., U.S. Patent No. 4,751,507 in view of IBM Technical Disclosure Bulletin titled Project management Environment and in view of Mederer et al., US Patent No. 5,864,782.

Hama teaches displaying the same image in display areas 22 and 23 where display area 22 displays the entire image at low resolution (Hama's coarse) while display area 23 displays a portion of the entire image at high resolution (Hama's fine).

The IBM Technical Disclosure Bulletin teaches displaying a flowchart that is larger than the display and allowing the user to scroll through the flowchart to view

different areas of the flowchart, see the page which begins with "category will use" of the EAST printout of this document which states in the middle of the page:

- In general, the PME user will be provided with scrollable screens which display and describe the contents of each data field and record in each of the project data tables. The user will be able to add, modify or delete data from any field in any table. These functions are common to most project management program products. In the case of the activity linkages tables, the PME user will be able to manipulate data in these tables directly from the flowchart display. —

Mederer teaches display 28 of figure 1 will display the flowgraph of figures 2 or 3, see column 5 lines 42-46, and from the drawings Mederer teaches to one of ordinary skill in the art when viewing figures 1 to 3 that based upon display area the lines of a flowgraph may be omitted since figure 1 has less display area to display a large flowgraph relative to display area while figures 2 and 3 have more display area to display the flowgraph which is similar to Hama's evergreen shown in figure 5 which has less detail in display area 22 and greater detail in display area 23. MPEP 2125 discusses using drawings as a prior art teaching.

The combination of Hama, the IBM Technical Disclosure Bulletin, and Mederer results in an entire large flowgraph being displayed in low resolution by Hama at display area 22 while a portion of the entire large flowgraph is being displayed in high resolution by Hama at display area 23 and the combination results, in manner similar to Mederer's drawings, with the low resolution entire large flowgraph displayed without lines between nodes and the high resolution portion of the entire large flowgraph displayed with lines between nodes because displaying an entire large flowgraph in a small area of the

display with the lines will make the nodes of the flowgraph indiscernible from other nodes and lines.

Appellants arguments at page 10 first paragraph lines 3-6 under the 103 heading, page 11 lines 7-10, and page 11 lines 15-18 are the same and are not persuasive because the combination set forth in the Final rejection's obvious statement in the paragraph spanning pages 6 and 7 of Hama, the IBM Technical Disclosure Bulletin, and Mederer results in an entire large flowgraph being displayed in low resolution by Hama at display area 22 while a portion of the entire large flowgraph is being displayed in high resolution by Hama at display area 23 and the combination results with the low resolution entire large flowgraph displayed without lines between nodes and the high resolution portion of the entire large flowgraph displayed with lines between nodes because displaying an entire large flowgraph in a small area of the display with the lines will make the nodes of the flowgraph indiscernible from other nodes and lines.

Appellants argument at page 11 lines 11-14 and 21-22 and page 12 lines 5-8 is not persuasive because the Final rejection's response to arguments at page 2 made reference to Mederer at column 5 lines 42-46 which describes display 28 of figure 1 will display the flowgraph of figures 2 or 3.

Appellants argument at page 11 lines 18-20 is not persuasive because display area 22 of Hama shows the evergreen tree with less detail and display area 23 shows the evergreen tree with more detail in a manner similar to appellants display of a

flowgraph with less detail having no lines between nodes and a flowgraph with more detail having lines between nodes.

Appellants argument at page 11 line 22 to page 12 line 7 and page 12 lines 9-13 is not persuasive because as discussed above the combination of Hama, the IBM Technical Disclosure Bulletin, and Mederer results in an entire large flowgraph being displayed in low resolution by Hama at display area 22 while a portion of the entire large flowgraph is being displayed in high resolution by Hama at display area 23 and the combination results with the low resolution entire large flowgraph displayed without lines between nodes and the high resolution portion of the entire large flowgraph displayed with lines between nodes because displaying an entire large flowgraph in a small area of the display with the lines will make the nodes of the flowgraph indiscernible from other nodes and lines.

Appellants comment at page 12 lines 8-9 is an admission that Mederer does teach "nodes are displayed without any connecting lines or nodes are displayed with interconnecting lines". With regard to the following comment at page 12 lines 9-13 the above discussed combination of Hama, the IBM Technical Disclosure Bulletin, and Mederer results in displaying Mederer's figure 1 and figures 2 or 3 at the same time.

The evidence of record shows one of ordinary skill had in his possession a number of solutions to displaying a large flowgraph and had good reason to pursue the known options within his or her technical grasp. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007), U.S. Supreme Court No. 04-1350 Decided April 30, 2007, 127 SCt 1727, 167 LEd2d 705 which stated:

The same constricted analysis led the Court of Appeals to conclude, in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was "obvious to try." *Id.*, at 289 (internal quotation marks omitted). When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103.

Thus, as stated in the Final Rejection, it would have been obvious to one of ordinary skill in the art at the time the invention was made to display a flowgraph image in Hama because a flowgraph is an image corresponding to a computer controlled graphic application and because the IBM Technical Disclosure Bulletin teaches displaying a flowchart image that is larger than the display and it would have been obvious to one of ordinary skill in the art at the time the invention was made to display in the navigator box an image of the flowgraph where the flowgraph does not show the lines interconnecting the nodes because displaying a large flowgraph in a small area of the display with the lines will make the nodes of the flowgraph indiscernible.

(11) Related Proceeding(s) Appendix

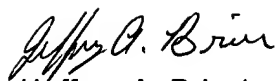
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Page 16

Respectfully submitted,



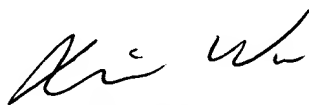
/Jeffery A. Brier/

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